

## REMARKS

In the Office Action mailed June 4, 2003, the Examiner requested that the Applicant provide (or reprovide) the Abstract; rejected claims 1-6 and 11-27 under 35 U.S.C. §103(a) as unpatentable over Sugiyama (U.S. Patent No. 5,392,284).

Concerning the Abstract, Applicant provides another replacement Abstract as requested by the Examiner.

By this amendment, Applicant adds new claims 28 and 29 to claim subject matter to which the Applicant is entitled. Claims 1-6 and 11-29 are currently pending.

The Examiner rejected claims 1-6 and 11-27 under 35 U.S.C. §103(a) as unpatentable over Sugiyama. Applicant traverses this rejection for at least the following reasons.

Claim 1 recites a communication apparatus for communicating over a plurality of channels. Moreover, claim 1 includes a combination of elements including, *inter alia*, notifying unit configured to notify a connected another communication apparatus of a number of usable channels based on a negotiation between the communication apparatus and a relay station being connected to the communication apparatus.

In contrast to claim 1, Sugiyama discloses a multimedia communication device that permits the user to select the transfer rate. In particular, Sugiyama discloses the following:

FIG. 3 is a view illustrating the constitution of a lamp switch provided on a part of the operation unit 15 for allowing the user to specify the transfer rate of an image, and displaying a current transfer rate of an image with the lighting of a lamp, in which the selection and a display of the transfer rate of the image is indicated with an image quality changeover switch 151 to the operator.

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(Sugiyama, col. 6, lines 58-65; see also FIGs. 3 and 6; and col. 8, ll. 37-39.) Because the user of Sugiyama's system specifies the transfer rate, there is no negotiation between a communication apparatus and a relay station. For at least this reason, Sugiyama fails to teach or suggest the combination of claim 1 including, for example, "notifying unit configured to notify a connected another communication apparatus of a number of usable channels based on a negotiation between the communication apparatus and a relay station being connected to the communication apparatus."

Claim 1 is thus allowable over Sugiyama.

The Examiner appears to take Official Notice with respect to the "selecting unit" recited in claim 1. (Office Action, p. 3.) However, the Examiner's Official Notice fails to cure the deficiencies of Sugiyama. Claim 1 is thus allowable over Sugiyama and Examiner's Official Notice, whether taken alone or in any reasonable combination. Therefore, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

The Examiner admits that Sugiyama fails to teach the "selecting unit," as recited in claim 1. The Examiner appears to cure that deficiency in Sugiyama by taking Official Notice that "the relationship between the number of channels and rate is very well known and taught in col 2 lines 18+ and col 6 lines 55+ and the table and col 11 lines 40 - 55." (Office Action, p. 3.) Concerning the Examiner taking official notice, Applicant refers the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice." ("Memorandum") In relevant part, the Memorandum states, "If the examiner is relying on personal knowledge to support the finding of what is known in the

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art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding" (Memorandum, p. 3, emphasis added). Applicant submits that the Examiner made a generalized statement regarding Applicant's claim 1 without any specific documentary evidence to support it. Indeed, the Examiner's generalized statements concerning Sugiyama at best seem to contradict his position, since there appears to be no relationship shown in Sugiyama between channels and rate. See, e.g., Sugiyama at Table 1 (showing number of channels, information transfer rates, audio transfer rates, image transfer rates, and image quality levels.) Applicant submits that deficiencies of the cited reference cannot be remedied by general conclusions about what is "basic knowledge" or "common sense." *In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Should the Examiner maintain the rejection after considering the arguments presented herein, Applicant submits that the Examiner must provide "the explicit basis on which the examiner regards the matter as subject to official notice and [allow Applicant] to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made" (*Id.* at 3), or else withdraw the rejection. Therefore, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

In the Office Action at p. 2, the Examiner identifies Sugiyama's "communicating members [terminal] A and [terminal] B." The Examiner then goes on to suggest that Sugiyama at col. 7, lines 55+ discusses a "[n]egotiation between a communication apparatus and a relay station." In particular, Sugiyama states:

In the ability exchange procedure P302, the own communication terminal A transmits its transfer rate ability

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and the terminal ability for audio and data, which have been preset to the partner's communication terminal B, and receives the partner's terminal ability such as a transfer rate ability from the partner's communication terminal B. The scope of ability compatible **between the own terminal ability and the partner's terminal ability** is stored in a RAM of the system control unit 16, together with the partner's terminal ability, as the communication capable ability at its communication.

(Sugiyama, col. 7, ll. 54-65.) As such, Sugiyama merely reveals an "exchange procedure" between two communication terminals A and B, not between a communication terminal and a relay station (e.g., a base station). Sugiyama thus fails to teach or suggest, the combination of claim 1 including, for example, "notifying unit configured to notify a connected another communication apparatus of a number of usable channels based on a negotiation between the communication apparatus and a relay station being connected to the communication apparatus. For this additional reason, claim 1 is allowable over Sugiyama and Examiner's Official Notice, whether taken alone or in any reasonable combination, and the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 2-5 and claims 19-22 depend directly from claim 1. Claim 6, although of different scope, recites a method capable of being performed by the communication apparatus of claim 1. Claims 11-18 depend directly from claim 6. Independent claim 23, although of different scope, includes recitations similar to those of claim 1. Claims 24-27 depend from claim 23. For at least the reasons given with respect to claim 1, claims 2-6 and 11-27 are allowable Sugiyama and Examiner's Official Notice, whether taken alone or in any reasonable combination. Therefore, the rejection of claims 2-6 and 11-27 under 35 U.S.C. § 103(a) should be withdrawn.

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New claims 28 and 29, although of different scope, include limitations similar to those of claim 1. Applicant thus submits that for at least the reasons given above, claims 28 and 29 are neither anticipated nor rendered obvious in view of the cited reference.

Accordingly, Applicant respectfully requests that this Amendment under 37 C.F.R. §1.116 be entered by the Examiner. Applicant submits that the proposed new claims 28 and 29 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that their claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

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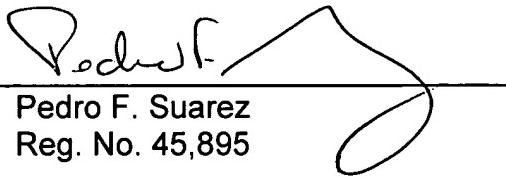
Respectfully submitted,

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